REMARKS

1. In response to the Office Action mailed May 18, 2005, Applicants respectfully request reconsideration. Claims 1-32 were last presented for examination. In the outstanding Office Action, claims 1-32 were rejected. By the foregoing Amendment, claim 28 has been amended. No claims have been added or canceled in this paper. Thus, upon entry of this paper, claims 1-32 will remain pending in this application. Of these thirty-two (32) claims, five (5) claims (claim 1, 22, 24, 31 and 32) are independent. Based on the above Amendments and following Remarks, Applicants respectfully request that all outstanding objections and rejections be reconsidered, and that they be withdrawn.

Art of Record

2. Applicants acknowledge receipt of form PTO-892 identifying additional references made of record by the Examiner.

3. Applicants acknowledge receipt of the form PTO-1449 filed by Applicants on February 28, 2005, which has been initialed by the Examiner indicating consideration of the references cited therein.

Claim Objections

4. Dependent claim 28 has been objected to because of an informality. Applicants have amended claim 28 to overcome this objection. Applicants respectfully request that this objection be reconsidered, and that it is withdrawn.

Claim Rejections under 35 U.S.C. §103(a)

5. Claims 1-5, 6-8, 13, 16, 22, 24-27 and 29-32 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Publication No. 2003/0101020 A1 to Matsushige (hereinafter, "Matsushige") in view of Japanese Patent No. 2000172536A to NEC CORP (hereinafter, "NEC"). Claims 18-21 and 23 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Matsushige in view of NEC as applied to claim 1 above, and further in view of U.S. Publication No. 2003/0101020 A1 to Hawkins, *et al.* (hereinafter,

"Hawkins"). Based upon the above Amendments and following Remarks, Applicants respectfully request reconsideration and withdrawal of these rejections.

6. Claim 1 recites: "[a] margin testing system...., comprising: a fault bypass module ... configured to intercept and mask at least one signal indicative of faults associated with one or more of said components during margin testing of said electronic system. (*See*, Applicants' claim 1, above). In rejecting claim 1, the Examiner recognized that Matsushige fails to teach a fault bypass module configured to intercept and mask signals indicative of one or more faults. Instead, the Examiner relied on NEC for allegedly disclosing this limitation. Applicants respectfully disagree.

7. In support of the Examiner's rejection, the Examiner relied on the Abstract and paragraphs 008-012 of NEC. This abstract states:

> A mask controller (42) controls the masking of interrupt signal, based on failure generation indication output by CPU(1). A receiving portion (44) judges whether failure process completion responses signal (121) is received from CPU in preset time. When the completion response signal is not received a diagnostic controller (40) release the mask and output an interrupt signal forcedly to CPU. (*See,* NEC, Abstract.)

8. Thus, although this abstract broadly teaches masking of interrupt signals, it does not teach that the mask controller (42), any other component, intercepts and masks a signal indicative of a fault. As such, Applicants respectfully submit that Abstract of NEC fails to teach or suggest a "fault bypass module ... configured to intercept and mask at least one signal indicative of faults associated with one or more of said components during margin testing of said electronic system," as recited in claim 1.

9. With regard to paragraphs 008-012 of NEC, the Examiner failed to identify what element disclosed in these paragraphs the Examiner is asserting allegedly discloses a fault bypass module. These five paragraphs disclose a myriad of components, such as, a central processing unit, a judgment processing, a masking control processing, a failure logging system, an approach, an output terminal, a mask control means, a non masker bull interruption terminal, and diagnostic equipment. None of these elements are analogous to Applicants' claimed fault bypass module. Should the Examiner continue to rely on this portion of NEC, Applicants respectfully request that pursuant to 37 C.F.R. §1.104(c)(2),

that the Examiner identify the particular component relied on by the Examiner and clearly explain the pertinence of the NEC reference.

10. Applicants further note that MPEP §706.02 states "If the document is in a language other than English and the examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the Examiner is relying upon in support of the rejection." The Examiner, however, merely provided a translation by a computer that on its face state "This document has been translated by computer. **So the translation may not reflect the original precisely**." (emphasis added). A review of the document supplied by the Examiner demonstrates that there are numerous errors in the translation making it impossible to discern from this computer generated translation the precise facts the Examiner is relying upon. Paragraphs 011 and 012 of the relied on section are reproduced below:

> [0011] Before a central processing unit starts the processing which does not permit interruption by this, by the mask control means in diagnostic equipment If the mask of the advice of failure generating by non masker bull interruption is carried out Since error processing is performed when a certain failure occurs at the event, it changes into the condition that processing is not interrupted by interruption of advice of a failure and interruption can be permitted and a mask is opened, it becomes possible after failure logging processing to return normally.
>
> [0012] Furthermore, since the mask which the central processing unit performed after predetermined time is disregarded and it is compulsorily notified by non masker bull interruption even when having resulted in the endless loop, while it was made the calamity and the central processing unit had carried out the mask of the advice of failure generating, it becomes possible to leave failure hysteresis, the omission of data required for failure analysis is lost, and improvement in failure analysis can be aimed at. (*See,* NEC, para. 11-12.)

11. As such, Applicants respectfully request that the Examiner provide the Applicants with an accurate translation of the NEC reference and that Examiner precisely identify the components being relied on. Moreover, Applicants respectfully submit that as far as the Applicant can tell, the relied on section does not disclose a fault bypass module as claimed. For example, if the Examiner is relying on the central processing unit discussed in the

section of NEC reproduced above, Applicants respectfully disagree with the Examiner. Although this section discloses a central processing unit and masking, it does not teach or suggest the central processing unit intercepting a signal indicative of a fault and masking the intercepted signal. As such, Applicants respectfully submit that this section, like the Abstract, fails to teach or suggest "fault bypass module ... configured to intercept and mask at least one signal indicative of faults associated with one or more of said components during margin testing of said electronic system," as recited in claim 1.

12. Applicants further respectfully submit that the Examiner has further failed to establish a *prima facie* case of obviousness for the additional reason that the Examiner has failed to establish a proper motivation to combine the Matsushige and the NEC references. As noted by the Federal Circuit in *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), specific reasons must be shown in the art suggesting a combination of references. (See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed."); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("[E]ven when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination.")).

13. In support of the Examiner's alleged motivation to combine, the Examiner relied on the Abstract of NEC, which is reproduced above. However, as discussed above, this abstract does not disclose a fault bypass module as claimed, nor does it mention anything about intercepting fault signals. As such, it is not possible for the Abstract of NEC to supply a motivation to combine the NEC and Matsushige references to achieve the claimed invention. Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection under §103(a) for the additional reason that NEC fails to provide a motivation to combine the NEC and Matsushige references.

14. Applicants further submit that independent claim 22 is likewise allowable over the art of record. Specifically, for at least the reasons noted above, none of the references taken alone or in combination, teach or suggest "a fault bypass module ... configured to intercept and mask signals indicative of one or more faults associated with one or more of

said components during margin testing of said electronic system," as recited in claim 22. Thus, Applicants respectfully submit that claim 22 is patentable over the art of record.

15. Applicants also submit that independent claim 24 is likewise allowable over the art of record. Specifically, for at least the reasons noted above, none of the references taken alone or in combination, teach or suggest "intercepting one or more signals each indicative of one or more faults associated with one or more components of said electronic system during margin testing thereof; and generating signals indicative of absence of said faults, thereby masking said intercepted signals," as recited in claim 24. As such, Applicants respectfully submit that claim 24 is patentable over the art of record.

16. Applicants further submit that independent claim 31 is likewise allowable over the art of record. Specifically, for at least the reasons noted above, none of the references taken alone or in combination, teach or suggest "means for intercepting at least one signal indicative of at least one fault associated with at least one component of an electronic system during margin testing thereof; and means for masking said intercepted at least one signal by generating at least one signal indicative of absence of said at least one fault," as recited in claim 31. Applicants therefore respectfully submit that claim 31 is patentable over the art of record.

17. Additionally, Applicants submit that independent claim 32 is allowable over the art of record. Independent claim 32 recites, in part, "a fault bypass module incorporated in said computer server, said fault bypass module configured to mask signals indicative of one or more faults associated with one or more of said components during margin testing of said computer server." In rejecting claim 32, the Examiner relied on the same basis as the Examiner relied on in rejecting claim 1. The Examiner, however, identified no support in any of the cited references for allegedly disclosing "a fault bypass module incorporated in said computer server...." As such, Applicants respectfully submit that claim 32 is patentable over the art of record for at least this reason.

Double Patenting Rejections

18. The Examiner has rejected claims 1-32 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 55-75 of U.S. Patent Publication No. 2004/0267482.

19. Applicants agree to file a terminal disclaimer disclaiming the terminal part of the statutory term of any patent granted on the captioned application, which would extend beyond the expiration date of the full statutory term of United States Patent Publication No. 2004/0267482 upon allowance of this application. Applicants respectfully assert that these rejections will be obviated by the filing of the terminal disclaimer.

20. Applicants have agreed to submit the terminal disclaimer solely to advance the prosecution of the application, without conceding that the double patenting rejection is properly based. In agreeing to file the terminal disclaimer, Applicants rely upon the rulings of the Federal Circuit that the filing of such a terminal disclaimer does not act as an admission, acquiescence or estoppel on the merits of the obviousness issue. See, e.g., Quad Environmental Tech v. Union Sanitary Dist., 946 F.2d 870, 874-875 (Fed. Cir. 1991); Ortho Pharmaceutical Corp. v. Smith, 959 F.2d 936, 941-942 (Fed. Cir. 1992).

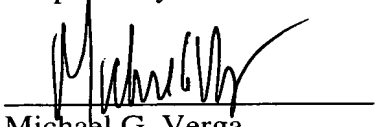
Dependent Claims

21. The dependent claims incorporate all of the subject matter of their respective independent claims and add additional subject matter which makes them a fortiori and independently patentable over the art of record. Accordingly, Applicants respectfully request that the outstanding rejections of the dependent claims be reconsidered and withdrawn.

Conclusion

22. In view of the foregoing, this application should be in condition for allowance. A notice to this effect is respectfully requested.

Respectfully submitted,



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